

REMARKS

Claims 3 – 8 are pending in this application.

Claim 7 is in independent form.

Entry of Amendment

The Amendment should be entered because it does not raise any new issues and reduces issues for appeal.

Foreign Priority

The indication that the priority document has been received is noted.

Drawings

In a telephone interview with the Examiner, the Examiner indicated that the drawings were accepted by the Examiner. This interview was held on July 29, 2005. The Examiner is requested to approve these drawing corrections by written confirmation to clarify the record.

Reply to Rejections

First Rejection

Claims 1-8 and 10 were rejected under 35 USC 103(a) as being unpatentable over Clark (USP 4,332,430) in view of Kobayashi (USP 4,907,991). This rejection, insofar as it pertains to the presently pending claims, is respectfully traversed.

Recognizing that Clark does not show or suggest that the contact portions (17) do not extend in a parallel direction to the terminal body, the Examiner relies on Kobayashi.

An object of the present invention is to provide a tab terminal electrically and surely connectable to both the electric connection part and the printed circuit board in spite of its small size and simple shape.

To achieve the above object, the tab terminal of the invention has limiting elements (the subject matters of claims 2 and, now canceled Claim 9) recited into Claim 7. The first and second contact portions of the invention electrically and reliably connect a plate tab terminal body and the printed circuit board while maintaining the desired height required for connection to an electrical connecting part in between the extension portion of the plate tab terminal body and the printed circuit board.

With the above-mentioned tab terminal, the first and second contact portions extend in directions toward each other, so that the first and second contact portions are not protruding outside the plate tab terminal body, which enables miniaturization of the tab terminal. Consequently, the tab terminal makes it possible to improve the efficiency of mounting of electrical parts onto the printed circuit board.

In this respect, the jumper connecting portions 3 according to Kobayashi are protruding outside the jumper body 2, so that the connective jumper of Kobayashi has to be large-scaled.

Furthermore, the tab terminal of the Applicant's invention is capable of securing a space for taking in a solder between the first and second contact portions and the printed circuit board. The solder filling this space assures the electrical connection of the tab terminal to the printed circuit board.

According to Kobayashi, however, the jumper connecting portions 3 have lower surfaces parallel to the substrate 7, so that it is impossible to secure a space for taking in a solder between the jumper connecting portions 3 and the wiring pattern 8 disposed on the substrate 7.

There is no *prima facie* case of obviousness established in the rejection. Even if there was a *prima facie* case of obviousness, which there is not, here the Office Action is directing attention to the individual isolated parts and not the combination as a whole. This was addressed by the Federal Circuit in the case of Hybritech Inc. v. Monoclonal Antibodies Inc. 231 USPQ 81, 93 (Fed. Cir. 1986) [cited in the MPEP] wherein the Court stated as follows:

Focusing on the obviousness of substitutions and the differences instead of the invention as a whole... was a legally improper way to simplify the difficulty termination of obviousness.

Also, as explained in the present specification and above, the present claimed device provides a result that must be taken into consideration before jumping to a conclusion of obviousness. See The Gillette Co. v. S.C. Johnson & Son, Inc. 16 USPQ2d 1923, 1928 (Fed. Cir. 1990) wherein the Court stated as follows:

An analysis of obviousness of a claimed combination must include consideration of the results achieved by that combination. As we explained in Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985). [Cited in the MPEP.]

With respect to the dependent claims, these claims are considered patentable at least for the same reasons as their base or intervening claims.

In an effort to reinforce the position of obviousness, the Office Action in section 6 provides reasoning to support its position. This will be answered below.

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection under 35 USC 103.

Second Rejection

Claims 9 and 11-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Clark and Kobayashi as applied in claims 1 and 7 and further in view of Guyette (U.S. Patent No. 4,037,898). This rejection is moot as these claims have been canceled.

Additional Comments

In section 6 of the Office Action, it was the Examiner's position that a rejection on obviousness can be based on the ordinary knowledge of those skilled in the art. There is no dispute with this general statement, but the Examiner's consideration is incomplete. For example, in the In re Rouffet case cited in the Office Action, the Court held that unexpected results must be considered and the entire record must be considered. In fact, in that case, the Board's holding of obviousness was overturned. Also, in In re Fine and In re Jones, cited in the Office Action, the Board of Appeals was reversed. In fact, in the In re Jones case (21 USPQ2d 1941, 1944) Fed. Circuit 1992) the Court stated as follows:

Conspicuously missing from this record is any evidence other than the PTO's speculation (if it is to be called evidence) that one of ordinary skill in the...art would have been motivated to make the modification of the prior art...

It appears that the Examiner asserts that one of ordinary skill in the art could make the claimed invention. But the capability is not a test of obviousness. See Ex Parte Levengood, 28 USPQ2d 1300 (BPAI 1993) cited in the MPEP in Section 2143.01, pages 2100-131.

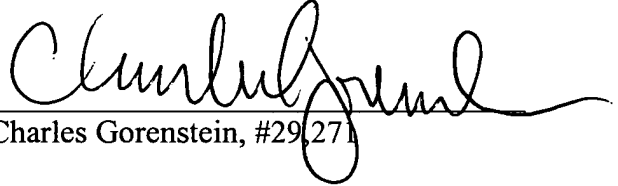
Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Elliot Goldberg (Reg. No. 33,347) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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